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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/806,873	04/03/2001	Alan Gary Blahey	P1998J096	6495

27810 7590 12/31/2001

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EXAMINER	
TOOMER, CEPHIA D	
ART UNIT	PAPER NUMBER
1714	

DATE MAILED: 12/31/2001

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/806,873	Applicant(s) BLAHEY ET AL.	
	Examiner Cephia D. Toomer	Art Unit 1714	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *10/9/2001* .

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1,2,4-7,9 and 10* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1,2,4-7,9 and 10* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11)☐ The proposed drawing correction filed on _____ is: a)☐ approved b)☐ disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12)☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____ .

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

14)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a) ☐ The translation of the foreign language provisional application has been received.

15)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ .
4) ☐ Interview Summary (PTO-413) Paper No(s). _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: .

DETAILED ACTION

This Office action is in response to the amendment filed October 9, 2001 in which claims 1, 2, 4, 6, 7 and 9 were amended and claims 3 and 8 were canceled.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 1, 2, 4-7 and 9-10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Inoue (US 5,744,430) for the reasons of record and for the additional reasons that follow.

Inoue fails to teach that the base oil possesses a KV of "between about 9 to about 20 cSt at 100 °C" (claim 1) or "from 9 to 20 cSt" (claim 6). However, a prima facie case of obviousness exists where the claimed ranges and the prior art do not overlap but are close enough that one skilled in the art would have expected them to have the same properties. Titaniun Metals Corps v. Banner 227 USPQ 773 (Fed. Cir. 1985). Also the claimed language "between about 9 to 20" reads on 8.

Applicant argues that Inoue prefers to keep the viscosity of the oil of his invention in the range of 5.6 to 12.5 cSt whereas the viscosity of the oil of the present invention has a viscosity greater than 13cSt.

A prima facie case of obviousness exists where the claimed ranges and the prior art do not overlap but are close enough that one skilled in the art would have expected

them to have the same properties. Titaniun Metals Corps v. Banner 227 USPQ 773 (Fed. Cir. 1985).

Applicant argues that Inoue obtains good performance because his oil must contain a very specific aromatic content, whereas in the present invention, enhanced performance is obtained by the combination of a phenolic antioxidant and a low level of VI improver.

Applicant's claims do not exclude base oils that contain the aromatic content specified in Inoue. Furthermore, Inoue teaches that the composition of his invention contains from 0.1 to 3% of the phenolic antioxidant and from about 1 to 10% by weight of the VI improver. These ranges encompass those of the present invention.

Claims 1, 2, 4 and 5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Vienna (US 3,36,114) for the reasons of record.

Applicant argues that several of the additives recited in Vienna are not suitable for use in engine oils, e.g. tricresyl phosphate and esters of chlorinated fatty acids.

The examiner respectfully disagrees. US Patent 5,726,133 (Blahey, which is discussed in the instant specification) and US Patent 5,807,813 (Yamoda) disclose that engine oils may contain these additives without any adverse effects (see Blahey, col. 4, lines 42-44; Yamoda, col. 6, lines 12-21). Also, it should be noted that the preamble of a claim is not a limitation where the claim is drawn to a product and the preamble merely recites a property or contemplated use. In re Riden, 138 USPQ 112 (CCPA 1963). Furthermore, even if these additives would adversely affect the oil composition, it is well settled that the omission of a component and its function from a combination is

an obvious expedient if the remaining components perform the same function as before. In re Karlson, 136 USPQ 184; In re Wilson, 53 USPQ 340; In re Marzocchi, 173 USPQ 228.

Applicant argues that the minimum and maximum values of the viscosity of the oil of Vienna would either make the oil too thin or too thick for use in the present invention.

It should be pointed out that Vienna does teach a range and that the preferred viscosity of Applicant's final composition falls within this range and a prima facie case of obviousness exists..

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Cephia D. Toomer whose telephone number is 703-308-2509. The examiner can normally be reached on Monday-Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vasu Jagannathan can be reached on 703-306-2777. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9310 for regular communications and 703-872-9310 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0661.

Cephia D. Toomer
Patent Examiner-1714

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December 23, 2001